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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,879	02/24/2004	Hirokazu Sawada	Q78018	8674

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WASHINGTON, DC 20037

EXAMINER
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GILLIAM, BARBARA LEE

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/784,879	<b>Applicant(s)</b> SAWADA ET AL	
	<b>Examiner</b> Barbara L. Gilliam	<b>Art Unit</b> 1752	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/19/05</u>   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Response to Amendment***

1. The amendment filed April 10, 2006 has been entered and fully considered.
2. Claims 1-21 are pending.
3. The claims are "product-by-process" claims. Applicant is reminded of MPEP 2113. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Nishio et al. (EP 853 132 A1).
  - a. The presensitized planographic printing plate of Nishio et al. comprises an aluminum alloy support and a light sensitive layer thereon (abstract). The aluminum alloy support, containing not more than 0.25 wt% of Si, not more than 0.40 wt% of Fe

not more than 0.05 wt % of Cu, not more than 0.03 wt% of Ti, meets the present limitations for the same. MPEP 2113. Nishio et al. is silent with respect to the surface area ratio and steepness of the aluminum support, however the aluminum support contains iron, silicon, copper and titanium in specific amounts, which are consistent with the presently claimed aluminum support. Further the aluminum support is subjected to the same surface treatments as the presently claimed lithographic printing plate support. For this reason, it is the Examiner's position the presensitized plate aluminum support of Sawada et al. inherently has a steepness and surface area ratio consistent with the presently claimed support. MPEP 2112 – 2112.02.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawada et al. (JP 200-037965).

a. Sawada et al. teach a lithographic printing plate substrate that is subjected to electrochemical roughening at the surface wherein the substrate contains 0.05 – 0.5 wt% Fe, 0.03 -0.15 wt % Si, 0.006-0.03 wt% Cu, 0.010-0.040 wt% Ti (abstract). Sawada et al. is silent with respect to the surface area ratio and steepness of the aluminum support, however the aluminum support contains iron, silicon, copper and

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titanium in specific amounts, which are consistent with the presently claimed aluminum support. Further the aluminum support is subjected to the same surface treatments as the presently claimed lithographic printing plate support. For this reason, it is the Examiner's position the presensitized plate aluminum support of Sawada et al. inherently has a steepness and surface area ratio consistent with the presently claimed support. MPEP 2112 – 2112.02. The Examiner asserts the presently claimed amount 0.032 to 0.040 wt% of Cu is obvious in view of the 0.006-0.03 wt% Cu contained in the printing plate substrate of Sawada et al. because the cited ranges are close enough that one of ordinary skill in the art would expect them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). Additionally, it would have been obvious to optimize the printing plate substrate of Sawada et al., and thus optimize the amount of the Fe, Si, Cu and Ti contained therein.

### ***Response to Arguments***

8. Applicant's arguments filed April 10, 2006 have been fully considered but they are not persuasive.

a. The presently claimed printing plate support is obvious in view of the substrate taught by Sawada et al. in JP 2000-037965. Applicant appears to be arguing superior results however Applicant has not submitted any data in support of this position. Applicant has not shown the criticality of the claimed Cu range. *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). Applicant is reminded

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that the arguments of counsel cannot take the place of evidence in the record. MPEP 716.01(c) II. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965).

b. In response to Applicant's argument that the references fail to show certain features of Applicant's invention, it is noted that the features upon which Applicant relies (i.e., the amount of Na contained in the substrate) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant's submission of "Fundamentals of Aluminum Materials and Industrial Technology" has not been considered because said reference is not listed on the appropriate form, PTO -1449 or PTO/SB/08. The English translation of said reference has not been considered either. Additionally the English translation is not a sworn translation.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara L. Gilliam whose telephone number is 571-272-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.


a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

b. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, reading "Barbara L. Gilliam". The signature is written in a cursive style with a large initial 'B'.

Barbara L. Gilliam  
Primary Examiner  
Art Unit 1752

bg

June 25, 2006